

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action mailed January 14, 2005. At the time of the Final Office Action, Claims 1-33 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-4, 6-7, 9-12, 14-15, 17-20, 22-23, 25-28, 30-31, and 33 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,119,014 issued to Alperovich et al. (hereinafter "*Alperovich*") in view of U.S. Patent No. 5,705,995 issued to Laflin et al. (hereinafter "*Laflin*"). The Examiner rejects Claims 8, 16, 24, and 32 under 35 U.S.C. §103(a) as being unpatentable over *Alperovich* in view *Laflin* as applied to Claims 1, 9, 17, and 25 above, and further in view of U.S. Publication No. 2001/0041571 A1 issued to Yuan (hereinafter "*Yuan*"). These rejections are respectfully traversed for the following reasons.

As a preliminary matter, Applicant is pleased to see the Examiner and Applicant have made substantial progress in the prosecution of this case. In particular, it appears that the Examiner and Applicant have agreed that the main reference, *Alperovich*, is deficient in a number of ways. (See Current Office Action: page 3.) Applicant is confident that the Examiner and Applicant can continue in this endeavor in order to reach a mutually agreeable resolution as to the allowability of the pending subject matter.

Turning to the merits of the current Office Action, Applicant respectfully notes that the Examiner has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis. According to MPEP §2143, to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations. (See generally MPEP §2143.) As an initial matter, the Examiner has failed to meet his burden with respect to the third criteria of non-obviousness, as none of the references cited by the Examiner disclose all of the limitations of the pending claims.

For example, while *Alperovich* may appear to be relevant to patentability of the pending claims, such a relevance is only tangential at best. This is because *Alperovich* fails to offer any system associated with “analyzing the message to determine if it contains pushed data, wherein the pushed data reflects a server initiated data transfer that is based on predetermined criteria; determining, if the message contains pushed data, whether the data is appropriate for a session currently being hosted by the mobile unit; and posting the data to the session if the data is appropriate for the session” as recited by Independent Claim 1. Note that these steps are inherently comprehensive in nature. For example, if a given reference fails to disclose “pushed data” then there could not be any analyzation if the message contains pushed data or a determination whether the [pushed] data is appropriate for the session. Coincidentally, this is exactly the case here.

For the above-identified limitations, the Examiner incorrectly relies on *Alperovich*. However, at the portions of *Alperovich* cited by the Examiner, such a disclosure is absent. This absence is only logical, as without having “pushed data” there can be no “analyzing” or “determining” as is clearly recited in Independent Claim 1. Note that the Examiner readily concedes this point, which is why *Laflin* has made an appearance in hopes of buttressing this §103 rejection. Turning to *Laflin*, this reference is associated with a dumb device, which merely receives a message and stores the message by category (or sub-category). (See Abstract of *Laflin*.) Note that, once the message is categorized, *Laflin* is unable to post the data to the session if the data is appropriate for the session, as is recited in Independent Claim 1. Applicant presumes that the Examiner has only offered *Laflin* in a meager attempt to offer the missing “pushed data,” which is noticeably missing from *Alperovich*. However, as evaluated in the analysis supra, *Alperovich* is no panacea, as it is flawed in a number of additional aspects. Additionally, there is nothing in *Yuan* that offers this missing disclosure, nor is there anything in *Alperovich* that is combinable with *Laflin* or *Yuan* that would inhibit the patentability of Independent Claim 1. Indeed, evaluating these references more closely reveals that *Yuan* and *Laflin* do not provide any subject matter relevant to the patentability of the pending claims, as both *Yuan* and *Laflin* fail to offer a teaching, a suggestion, or a disclosure associated with the above-identified limitation.

For at least these reasons, Independent Claim 1 is allowable over the *Alperovich-Laflin* and the *Alperovich-Laflin-Yuan* combinations. In addition, Independent Claims 9, 17,

25, and 33 include a limitation that is similar, but not identical, to that of Independent Claim 1. Accordingly, these Independent Claims are also allowable over the proffered combinations. Additionally, the dependent claims corresponding to these Independent Claims are also allowable for analogous reasons.

Applicant also wishes to note that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, usage of the *Alperovich* reference or of the proposed the *Alperovich-Laflin* or the *Alperovich-Laflin-Yuan* combinations is still improper because the Examiner has not shown the required suggestion or motivation in *Alperovich*, *Laflin*, or in *Yuan*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>1</sup> Thus, the sheer fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.<sup>2</sup>

Nothing in *Alperovich*, *Laflin*, or in *Yuan* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.<sup>3</sup> This is because the references fail to include the above-identified functionality and, therefore, are precluded from rendering the pending claims unpatentable. Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under M.P.E.P.<sup>4</sup> guidelines and governing Federal Circuit case law.<sup>5</sup> The M.P.E.P. consistently

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<sup>1</sup> M.P.E.P. §2143.01 (emphasis in original).

<sup>2</sup> *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

<sup>3</sup> If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

<sup>4</sup> See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

<sup>5</sup> For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion,

confirms that this approach is improper and, thus, it should not be used here.<sup>6</sup> Moreover, under the M.P.E.P., such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”<sup>7</sup> Under such circumstances, the Examiner must point to some concrete evidence in the record in support of the rejection, rather than relying on an assessment of what is “well recognized” or what a skilled artisan would be “well aware.”<sup>8</sup>

In the context of the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a prima facie case of obviousness.

Thus, all of the pending claims have been shown to be allowable, as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these pending claims.

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teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

<sup>6</sup> See M.P.E.P. §2145.

<sup>7</sup> See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

<sup>8</sup> See *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,  
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